

A. Claim 1

Claim 1 recites, “the device for processing further comprising a first ring-shaped plate and a second ring-shaped plate provided inside the enclosure and formed so as to surround the tube, wherein the first ring-shaped plate is axially offset from the second ring-shaped plate so that the first ring-shaped plate is provided above the window of the wall of the enclosure and the second ring-shaped plate is provided below the window of the wall of the enclosure.”

As set forth on page 6 of the present Application, the ring-shaped plates, i.e., elements 28 and 30, form short circuits for the electromagnetic field introduced into the enclosure so as to axially confine the field to have a maximum intensity level of the effective treatment area.

In the July 31, 2008 Amendment, Applicant argued that neither Lieber nor Ota teach or suggest the claimed ring-shaped plates. In response, the Examiner maintains that elements 3 and 4 of Lieber disclose the claimed ring-shaped plates (pg. 3 of current Office Action). Elements 3 and 4 of Lieber, however, are upper and lower metal covers for the container 6 (see Figure). The metal covers 3 and 4 are in no manner provided “inside” the enclosure, as recited in claim 1. As shown in the figure of Lieber, the covers 3 and 4 merely cover the upper and lower openings of the container 6 and are sealed to upper and lower ends of the container 2 via the seals 16. Furthermore, the upper and lower covers 3 and 4 do not actually “surround” the container 2 (alleged tube). Rather, they merely cover the top and bottom openings of the container 2, respectively.

Since Ota fails to cure the above-deficient teachings of Lieber, Applicant submits that claim 1 is patentable over the cited references.

B. Claims 2-7 and 9

Applicant submits that claims 2-7 and 9 are patentable at least by virtue of their dependency. In addition, claims 2-7 and 9 recite various dimensions of the claimed enclosure. The Examiner continues to maintain that it would have been a matter of obvious design choice for one of ordinary skill in the art to select/optimize the inside diameter of the enclosure (pg. 4 of Office Action).

In regard to the above, Applicant again notes that as discussed in the MPEP¹, it is only a design choice to optimize variables that have been established as result effective. For example, *In Re Boesch and Slaney*² is only applicable to the optimization of a variable that has been recognized as achieving a result. In *In Re Boesch and Slaney*, the claims were directed to a material having specific amounts of nickel and other elements. The Board of Patent Appeals and Interferences found that “lowering the Nv value of a Co-Cr-Ni alloy and deletion of metals not consumed in precipitation from the Nv calculation are expressly suggested” (emphasis added) by prior art reference U.S. Patent No. 3,837,838.³ The U.S. Court of Customs and Patent Appeals relied on this evidence regarding modifying the specific amounts of material when it upheld the Board’s decision.

¹ See MPEP §2144.05.II.B. (page 2100-143).

² *In Re Boesch and Slaney*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

³ *In Re Boesch*, , 617 F.2d at 276, 205 USPQ at 219.

In contrast, in the present case, there is no such evidence of any suggestion regarding modifying the inside diameter of the alleged enclosures of Lieber or Ota so that it is within one of the recited ranges.

C. Claims 8, 10-13, 15-17 and 19

Applicant submits that claims 8, 10-13, 15-17 and 19 are patentable at least by virtue of their dependency.

D. Claim 20

Applicant submits that claim 20 is patentable at least by virtue of its dependency. In addition, claim 20 recites that the first ring-shaped plate and the second ring-shaped plate are each respectively supported on an axially slidable rod.

On page 5 of the Office Action, the Examiner maintains that making the apparatus adjustable is obvious to one of ordinary skill in the art. As an initial matter, Applicant submits that none of the references discloses the claimed ring-shaped plates, let alone an axially slidable rod on which the ring-shaped plates are supported. The Examiner has failed to indicate where the rod is alleged to be taught by Lieber.

Additionally, even if Applicant assumes, *arguendo*, that the upper and lower covers 3 and 4 of Lieber disclose ring-shaped plates, the covers 3 and 4 are already sealed to the container 2 via the seals 16 and are therefore supported by the container 2, as well as by the outer surface of the container 6. Thus, there is no reason or need for an axially slidable rod to be provided in the container 6 of Lieber to support the covers 3 and 4.

At least based on the foregoing, Applicant submits that claim 20 is patentable over the cited reference.

II. Rejection under 35 U.S.C. § 103(a) in view of Lieber, Ota and U.S. Patent No. 5,225,740 to Ohkawa (“Ohkawa”).

The Examiner has rejected claim 14 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lieber, Ota and Ohkawa. Since claim 14 is dependent upon claim 1, and Ohkawa fails to cure the deficient teachings of Lieber and Ota, in regard to claim 1, Applicant submits that claim 14 is patentable at least by virtue of its dependency.

III. Rejection under 35 U.S.C. § 103(a) in view of Lieber, Ota and U.S. Patent No. 4,970,435 to Tanaka et al. (“Tanaka”).

The Examiner has rejected claim 18 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lieber, Ota and Tanaka. Since claim 18 is dependent upon claim 1, and Tanaka fails to cure the deficient teachings of Lieber and Ota, in regard to claim 1, Applicant submits that claim 18 is patentable at least by virtue of its dependency.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

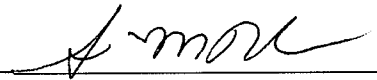
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